Supreme Court, U.S.
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No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1989

JAMES CONSTANT

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC.

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

Pro se petitioner

QUESTIONS PRESENTED FOR REVIEW

1. Does selling parts bar the infringement of a patent by computer systems created using the parts, where the seller instructs the infringing computer structure and function and program kits in his technical literature.

2. Does a court's determination that a patent is not infringed render moot the dispute as to patent's validity.

3. Must a reason be given before references can be combined to support the obviousness of making an invention.

4. Absent a statutory bar, can the petitioner's own patent be 'prior art' to him.

5. Can a patented device not previously before the court, which includes structures but not functions of a patented device previously litigated in another court, require determination on its own facts.

6. In the present and earlier litigations involving the same parties, does a first patent which has been declared invalid by another court in the earlier litigation create a collateral estoppel barrier in the present litigation without giving the patentee-petitioner a chance to demonstrate that he did not have a full and fair chance to litigate his first patent in the earlier case.

7. Is a combination of references, prohibited under any subsection of 35 USC 102, prior art for purposes of 35 USC 103.

8. In the determination of prior art under 35 USC 102, for purposes of 35 USC 103, must a comparison of the claimed invention with the disclosure of each cited reference be made to determine the number of claim limitations in common with each reference and, is a given reference prior art when it has

nothing in common with any claim limitation.

9. In an obviousness analysis, is identity of function, between the claimed invention and prior art, required absent which consideration of structure should not be made.

10. Can references used to obviate a patent be applied without considering the prior art as a whole.

11. Whether the combination of references used against the 660 Patent suggest the claimed first-in-J-out (FIJO) time reversal and time compression functions of a filter.

12. Whether the court's conclusion that "The level of ordinary skill in the art is that of an engineer with a BSEE who has had several years experience in the field of digital electronics" is error because it is not based on any factual inquiry of the factors determining the level of ordinary skill.

13. Whether the secondary evidence of infringement of a patent must be considered before the decision on obviousness of the patent is reached and, thus, whether the court's conclusion that "The objective evidence does not support a finding of non-obviousness" is error because it was made before the infringement of the 660 Patent by AMD's 7910/11 and 79C12/14 devices was determined.

14. Whether petitioner was given the opportunity to show that in fact the 660 Patent is infringed by AMD's 7910/11 and 79C12/14 devices and to thereby establish commercial success that makes the invention not obvious.

15. Whether the doctrine of file wrapper estoppel is not applicable where literal infringement has been found and the patentee does not rely upon the doctrine of equivalents.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the Judgement of the United States Court of Appeals for the Federal Circuit dated 5 October, 1989 attached as APPENDIX A-2.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its Judgement attached as APPENDIX A-2 affirming the Orders and Judgement of the District Court Northern District of California attached as APPENDIX B holding two patents not infringed and one patent is invalid.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

STATEMENT OF THE CASE

Petitioner contends that respondent, Advanced Micro-Devices, Inc. (hereinafter referred to as "AMD") infringes Patent No. 4,006,351 (hereinafter referred to as "351" Patent) by AMD's 29300 and 29500 family devices. Compl. Exh D; infringes Patent No. 4,080,660 (hereinafter referred to as "660" Patent) by AMD's 29300,29500,7910/11, 79C12/14 devices. Compl. Exh. E; and infringes Patent No. 4,107,458 (hereinafter referred to as "458" Patent) by AMD's 9568, 9518, 8068 devices. Compl. Exh. F.

AMD requested summary judgement that it does not infringe the 351 and 660 Patents by AMD's 29300 and 29500 family devices. Petitioner requested summary judgement that AMD infringes the 351 and 660 Patents by AMD's 29300 and 29500 family devices. The district court held for AMD. B-2.

AMD requested summary judgement that

the 660 Patent is invalid for obviousness under 35 USC 103, since it incorporates the same invention the CAFC has already held invalid. * At bench trial, AMD relied on the Constant Patent No. 3,950,635 (hereinafter referred to as the "635" Patent), the article by Springer "High Speed Shift Registers use TTL RAMs and Counters to do All the Shifting", and the Bird Patent No. 3,553,651 (hereinafter referred to as the "651" Patent). The district court held for AMD. B-10.

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* In Constant v. AMD, 7 USPQ2d 1057,1061-65, the CAFC found petitioner's Patent No. 4,438,491 ("491" Patent) anticipated and obvious considering Intel specification sheet Exhibit 5, and the CAFC found petitioner's Patent No. 3,950,635 ("635" Patent) anticipated and obvious considering the Allen & Westerfield ("A&W") article (Journal of the Acoustical Society of America, Vol 36, No 1, Jan 64), Patent No. 3,295,107 ("107" Patent) to Stalcup, and the article by Springer, infra.

The CAFC denied petitioner's motion to file a supplement to the amended brief already filed. A-3. Thus, due to the 50 page rule of the CAFC for filing briefs, petitioner was denied from making a full argument on appeal which responds to the district court's finding that the collateral estoppel effects of the earlier case Constant v. AMD, 7 USPQ2d 1057 (CAFC 1988) apply to the present case.

Petitioner requested summary judgement that AMD infringes the 660 Patent by AMD's 7910/11,79C12/C14 devices. Since the district court held the 660 Patent invalid, it did not adjudicate this request. B-22.

AMD requested summary judgement that it does not infringe the 458 Patent. Petitioner requested summary judgement that AMD infringes the 458 Patent by AMD's 9568, 9518,8068 devices. The district court held for AMD. B-21.

REASONS FOR GRANTING THE WRIT

I. The 351 and 660 Patents are Infringed by AMD's 29300 and 29500 Family Devices.

The 29300 and 29500 familes consist of parts used to create computer systems. The structures and functions of systems are shown throughout AMD's technical literature (identified in petitioner's motions for summary judgement DN=46,48) (Docket Number hereinafter referred to as "DN").

1. Infringement of the 351 Patent

AMD infringes the 351 Patent because the 29300 and 29500 systems compute and multiply identical functions in identical means described in elements 1,4,5 of Fig 1a of the 351 Patent. For identity of structure see EXHIBITS 1,2,3 in DN 46. For identity of functions see EXHIBITS 4, 5,6,7 in DN 46. As shown in EXHIBITS 2

through 7 in DN 46, a number of 29300 and 29500 systems were built and tested by AMD. For identification of 29300 and 29500 systems throughout AMD's technical litirature, for identification of 29300 and 29500 systems actually built by AMD see page 4 in DN 46. As shown in EXHIBIT 1 of DN 46, the literal terms of claim 1 of the 351 patent read on the first and second means of the 29300 and 29500 systems.

The preamble of claim 1 of the 351 Patent is in Jepson format. A Jepson format preamble is not part of a claim. 37 CFR 1.75(e).

Claims of the 351 Patent are means plus function claims. The last paragraph of 35 USC 112 directs that a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof".

The 29300 and 29500 systems infringe claim 1 of the 351 Patent because every function of the claimed combination is performed by each accused system, the structures performing those functions being identicals or equivalents of the structures disclosed in the 351 Patent, literally or equivalently under 35 USC 112 paragraph 6. Pennwalt Corp. v. Durand-Wayland, Inc., 4 USPQ2d 1737 (CAFC 1987).

2. Infringement of the 660 Patent

AMD infringes the 660 Patent because the 29300 and 29500 systems read signals from a random access memory ("RAM") in the same or time reverse sequence as signals are written into the RAM, in identical means described in elements 7 and 11 of Fig 2 of the 660 Patent. For identity of structure see EXHIBITS 1,2,3 in DN 48. For identity of function see

EXHIBITS 4,5,6,7 in DN 48. As shown in EXHIBITS 2 through 7 in DN 48, a number of 29300 and 29500 systems were built and tested by AMD. For identification of 29300 and 29500 systems throughout AMD's technical literature, for identification of 29300 and 29500 systems actually built by AMD see page 4 in DN 48. As shown in EXHIBIT 1 of DN 48, the literal terms of claims 1,2,4 of the 660 patent read on the storing and addressing/shifting means of the 29300 and 29500 systems.

Claims of the 660 Patent are means plus function claims. The last paragraph of 35 USC 112 directs that a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof".

The 29300 and 29500 systems infringe claims 1,2,4 of the 660 Patent because

every function of the claimed combination is performed by each accused system, the structures performing those functions being identicals or equivalents of the 660 Patent, literally or equivalently under 35 USC 112 paragraph 6. Pennwalt, supra.

3. The Court's Order (B-2) is Error

The Court's order holding that the 351 and 660 Patents are not infringed by AMD's 29300 and 29500 families (B-2) is error because the preponderance of the evidence establishes that these systems infringe each patent directly, by inducement, and by contribution. The following facts, which respond to the individual findings by the court (B-4 through B-7), create genuine issues of material facts which preclude summary judgement for AMD.

1. The sale of parts does not bar direct infringement when "operable assemblies" of parts are made and tested by AMD enabling it to deliver the patented combination to its customers. Paper Converting Machine Co. v. Magna-Graphics Corp., 220 USPQ 591,597 (CAFC 1984). AMD admits that each part of the 29300 and 29500 families has been fully tested by AMD and, each system could be built by customers for a wide number of applications. See AMD's response to petitioner's 2nd admissions requests No 19 (DA 2-19); DA 3-23 (DN 52). AMD admits except for multipliers, none of the other parts from AMD's 29300 and 29500 families is individually capable of implementing algorithms. See AMD's answer to petitioner's Interrogatories

3rd set No 2 (DI 3-2)(DN 52). * AMD's technical literature states that the 29300 and 29500 families have been developed to provide systems. See EXHIBIT 4 (Chapter 1 Introduction, Chapter 3 Array Processing Algorithms, Chapter 4 Systems Design)(DN 52). In effect, AMD sells parts that can only be used in systems it instructs in its technical literature

a. Direct Infringement

AMD stipulates that the 29300 and 29500 systems are made, used and sold by AMD. See AMD letters to petitioner 1/12/89 and 1/18/89 attached to reply to AMD's opposition (DN 62).

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* In Constant v. AMD, 7 USPQ2d 1057,1063 Intel sold individual 2920 chips which could be used in combination with other chips to create computer systems. Since the SP20 kit for programming the 2920 chips was publicly available for infringing as well as non-infringing programs, the 2920 system (distinct from 2920 part) was held by the CAFC to anticipate and obviate petitioner's Patent No. 4,438,491

The evidence shows that AMD makes, uses and sells the 29300 and 29500 systems. p 10 APP A INSTR (DN 51). A number of systems were built and tested by AMD to support systems sales. See p 4 DN 46,48 for identification of systems actually built and tested by AMD in EXHIBITS 4,5,6 (DN 52); see letter 12/16/88 from AMD to petitioner (DN 52). The evidence also establishes that AMD makes, uses and sells the 29C300 system Evaluation Board to support its systems sales. p 5-1, Fig 5-1 EXHIBIT 5 (DN 52).

b. Inducement and Contribution

AMD induces and contributes to the infringement through its instructions contained in its technical literature. See pp 15-16 APP A INSTR (DN 51). AMD's technical literature provides and instructs how to make and use 29300 and 29500 systems.

See systems identified at p 1 in APP A INSTR (DN 51). Systems are specially designed for programs implementing infringing algorithms (FFT,IIR,FIR, division, multiplication). pp 9-24 EXHIBIT 4 (DN 52). See also pp 10-16 APP A INSTR (DN 51). * AMD's technical literature provides and instructs the infringing algorithms computed by the 29300 and 29500 systems. p 11 APP A INSTR (DN 51). AMD's technical literature provides and instructs the hardware and software tools used to program the

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* Fig 1a in the 351 Patent shows how the claimed recursive filter implemented as a matched clutter filter is obtained by computing two FFT's, one division, and one multiplication. Fig 2 in the 660 Patent shows how the claimed digital time scale inversion system is computed in a convolution (FIR) filter

infringing algorithms into the 29300 and 29500 systems. pp 11-12 APP A INSTR (DN 51). See also AMD's admissions at pp 17-20 APP A INSTR (DN 51). AMD admits (1) that systems made up of parts from AMD's 29300 and 29500 families could be designed in such a manner to implement algorithms (FFT,IIR,division, FIR)(DI 3-2)(DN 52), (2) that hardware and software kits are available in the marketplace and that such products can be used to program the 29300 and 29500 systems. DA 2-14; DA 2-15;DA 3-18 (DN 52), (3) that specific programs for computing the FFT,IIR, division,multiplication and FIR algorithms of the 351 and 660 Patents can be developed using the hardware and software tools. DA 2-16;DA 3-20 (DN 52), (4) that the 29300 and 29500 systems could be programmed to compute a large number of algorithms including the FFT,IIR,divide,multiply,and

FIR algorithms. DA 2-17;DA 3-21 (DN 52), (5) that AMD has communicated with third parties to make and use hardware and software support tools. DA 3-25(a) (DN 52), (6) that AMD provides hardware and software tools and kits. See Chapter 5 in EXHIBIT 5 (DN 52); see p 11 in APP A INSTR (DN 51). In short, AMD's customers buy the individual parts and then create their systems by following AMD's instructions for creating systems and programs using hardware and software tools and kits contained in AMD's technical literature.

2. Theoretically, a large number of systems could be built out of parts from AMD's 29300 and 29500 families. However, the claim limitations require certain structures. The 29300 and 29500 systems are specially designed for infringing structures. See EXHIBITS 1,2,3 in DN 46, 48. These structures are shown throughout

AMD's literature. See systems identified at p 1 APP A INSTR (DN 51). No structures other than the infringing structures are shown in AMD's literature. Further, while any computer can theoretically be programmed for an infinite number of possible algorithms, the claim limitations require certain algorithms (FFT,IIR,FIR,division, multiplication). The 29300 and 29500 systems are specially designed for computing infringing algorithms. See Chapter 3 EXHIBIT 4 (DN 52). No programs other than the infringing programs (FFT, IIR,FIR,division,multiplication) are shown in AMD's literature. Moreover, infringement cannot be avoided by the fact that an accused device has additional elements or functions not found in the patented device. *

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* (note continued on next page)

(note continued from previous page)

* Cochrane v. Deener, 94 US 780, 786, 24 LEd 139 (Modification by mere addition of elements or functions cannot negate infringement); Eastern Rotorcraft Corp. v. U.S., 184 Ct Cl 709, 397 F2d 978,981, 154 USPQ 43,45, 158 USPQ 294, later proceeding 194 Ct Cl 1042 (infringement not avoided by adding an additional element); McCullough Tool Co. v. Well Surveys, Inc., 343 F2d 381,402, 145 USPQ 6,22 (CA10 Okla), cert den 383 US 933, 15 L Ed2d 851, 86 S Ct 1061, 148 USPQ 772, reh den 384 US 947, 16 LEd2d 545, 86 S Ct 1452 and reh den 385 US 995, 17 LEd2d 455, 87 S Ct 593 (infringement not avoided by performing additional functions); Acme Highway Products Corp. v. D.S.Brown Co., 473 F2d 849,855,177 USPQ 130, 135 (CA6 Oh) cert den 414 US 824, 38 LEd2d 57, 94 S Ct 125, 179 USPQ 321 (An accused device cannot escape infringement by merely adding features). Foregoing cases cited in Amstar Corp. v. Envirotech Corp., 730 F2d 1476, 221 USPQ 649, 653 (CAFC 1984) cert den (US) LEd2d 240, 105 S Ct 306, 224 USPQ 616.

Radio Steel & Mfg Co. v. MTD Products, Inc., 221 USPQ 657,663-64 (CAFC 1984)(accused device that contains same feature as patented device cannot escape infringement because in it that feature performs additional functions it does not perform in patented device); Hayes Spray Gun Co. v. E.C.Brown Co., 291 F2d 319, 129 USPQ 383 (CA9 Cal)(The addition of an element to a patent structure does not avoid infringement).

3. The 351 Patent is infringed by 29300 and 29500 systems which can be programmed to constitute the claimed recursive filter implemented as a matched clutter filter. Fig 1a in the 351 Patent shows how the claimed recursive filter as a matched clutter filter is obtained by computing two FFT's, one division, and one multiplication. The 29300 and 29500 systems are specially designed for programs implementing infringing algorithms (FFT,IIR,FIR,division, multiplication). pp 9-24 EXHIBIT 4 (DN 52). See Also pp 10-16 APP A INSTR (DN 51).

4. The fact that individual parts of the 29300 and 29500 systems do not constitute a recursive filter implemented as a matched clutter filter is not relevant. Petitioner does not accuse that any individual part from AMD's 29300 and 29500 families constitutes a recursive filter implemented as a

matched clutter filter. Rather, petitioner accuses that systems created using parts form AMD's 29300 and 29500 families can be programmed to constitute a recursive filter implemented as a matched clutter filter. See DN 46; see footnote page 13 supra.

5. AMD admits and the evidence shows that it makes, uses and sells systems (see 1a supra) but denies that it programs for infringing use. Theoretically, a computer can be programmed to perform any function. Pennwalt, supra. However, the claim limitations require the performance of specified functions (FFT,IIR,FIR,division, multiplication). The 29300 and 29500 systems are specially designed for computing these functions. See Chapter 3 EXHIBIT 4 (DN 52). The following factors have relevance to the issue of computer programs (a) the existence of hardware and software tools and kits for

implementing programs and (b) the relevance of programs to the claimed invention. Constant, supra 1063. AMD admits that hardware and software tools are available in the marketplace and that such products can be used to program the 29300 and 29500 systems to implement algorithms (FFT,IIR, division,FIR), DI 3-2;DA 2-14;DA 2-15; DA 3-18 (DN 52). Moreover, programs for the FFT,IIR,division,FIR are relevant to the 351 and 660 inventions. See footnote page 13 supra.

6. Inducement occurs because AMD sells products capable of infringing use through its instructions contained in its technical literature. Chisum 17.04(4)(f) Note 19 and Supplement citations (numerous decisions find active inducement where a defendant selling products capable of infringing use provides through labels, advertizing or other sales methods instructions and directions as to the infrin-

ging use); Moleculon Research Corp. v. CBS, Inc., 793 F2d 1261,1272, 229 USPQ 805 (CAFC 1986)(circumstantial evidence of extensive sales, dissemination of an instruction sheet, and the availability of a solution booklet; defendant's assertion that without evidence of direct infringement it cannot be liable for inducing infringement must fail, since proof of inducing or direct infringement does not require direct, as opposed to circumstantial evidence). The evidence shows that AMD's technical literature provides and instructs how to make and use the 29300 and 29500 infringing structures, provides and instructs the infringing algorithms and programs computed by these structures and provides and instructs the hardware and software tools that can be used to program the infringing programs. See 1b supra.

7. Same as 6 supra.

8. Not relevant. Petitioner does not accuse that any individual part from AMD's 29300 and 29500 families includes the elements claimed in the 660 Patent. Rather, petitioner accuses that systems made using parts from AMD's 29300 and 29500 families includes the elements claimed in the 660 Patent. See DN 48; see footnote page 13 supra.

9. Same as 5 supra. When the accused 29300 and 29500 systems are programmed to compute a FIR filter they constitute the claimed time inversion system in the 660 Patent. See footnote page 13 supra.

10. Same as 9 supra.

11. Same as 6 supra. When the accused 29300 and 29500 systems are programmed to compute the FIR filter they constitute the claimed time inversion system in the 660 Patent. See footnote page 13 supra.

12. Same as 11 supra.

13 and 14. Same as 1 supra.

II. Non-Infringement of the 660 Patent Renders Moot Dispute as to Patent's Validity

The court's order filed 27 January,1989 (B-2) held that the 660 Patent was not infringed by AMD, and the court's order filed 16 March, 1989 (B-10) held that the 660 Patent was invalid under 35 USC 103. However, the court's order invalidating the 660 Patent (B-10) is error because the court's determination that the 660 Patent was not infringed by AMD renders moot dispute as to patent's validity. Advance Transformer Co. v. Levinson, 5 USPQ2d 1600,1603 (CAFC 1988)(Appelate court's determination that patent was not infringed renders moot dispute as to patent's validity, and the federal district court's holding that patent is invalid is therefore vacated).

III. The 660 Patent is Valid on Merits

The court applies the combination of the Constant Patent No. 3,950,635 ("635"), the Springer article, and Bird Patent No. 3,553,651 ("651") to invalidate the 660 Patent. The court finds that there are no differences between (1) the structure of the 660 Patent and the structure of the 635 Patent (B-15) and (2) the function of the 660 Patent and the function of the Bird 651 Patent.

In Constant v. AMD, 7 USPQ2d 1057 the court applies the A&W article, the Stalcup patent, and the Springer article to invalidate the 635 Patent. The court states that the Springer "article was found to have disclosed every element of the invention claimed in the 635 Patent, except the specific filter application contained in the Patent" (B-12) and "Mr.

Constant is collaterally estopped from relitigating the decision of the Circuit" (B-15).

1. No Reason Given for Combining References

In the court's view, it is sufficient if the structure and function of the 660 Patent are found in different references. This view is error because it fails to give a reason for combining references.*

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* This Court has established that before references can be combined there must be some reason for the combination other than that gleaned from the invention itself. Something in the prior art as a whole must support the desirability, and thus obviousness of making the invention. Uniroyal v. Rudkin-Wiley Corp., 5 USPQ2d 1434,1438 (CAFC 1988). It is impermissible to disregard portions of prior art reference that teaches away from invention. Akzo N.V. v. USITC, 908 F2d 1471,1481, 1 USPQ2d 1241,1246 (CAFC 1988) cert den 107 SCt 2490 (1987); W.L.Gore & Assoc. v. Garlock, Inc., 721 F2d 1540,1550, 220 USPQ 303,311 (CAFC 1983) cert den 469 US 851 (1984), At all costs, the mistake of picking random bits of various prior art references and employing them "as a mosaic to recreate a facsimile of the claimed invention must be avoided. Id 1552,312

2. Petitioner's 635 Patent Cannot Be Prior Art To Him

The 635 Patent is not prior art against the 660 Patent. Reading & Bates Construction Co. v. Baker Resources Co., 748 F2d 645, 223 USPQ 1168 (CAFC 1984); In re Fout, 213 USPQ 532 (CCPA 1982) ("Absent a statutory bar under 35 USC 102(b),(c) or (d), an applicant's own invention cannot be 'prior art' to him"). If the 635 Patent is withdrawn as prior art (as it should), there is no structure in the Springer and Bird references to apply against the 660 Patent.

3. Collateral Estoppel Does Not Apply

Collateral estoppel serves to preclude the relitigation by the same parties of issues actually litigated, and necessarily determined, in a prior proceeding, Lawlor v. National Screen Service Corp., 349 US 322, 75 SCt 865, 99 LEd 1122 (1955);

Chromalloy American Corp. v. Kenneth Gordon Ltd., 736 F2d 694, 222 USPQ 187 (CAFC 1984); Mother's Restaurant, Inc. v. Mama's Pizza, Inc., 723 F2d 1566, 221 USPQ 394 (CAFC 1983); International Order of Job's Daughters v. Lindeburg & Co., 727 F2d 1087, 220 USPQ 1017 (CAFC 1984).

The issue of validity of the 660 Patent under 35 USC 103 considering the 635 Patent, the Springer article, and the Bird 651 Patent was never actually litigated, and necessarily determined, in Constant, supra in which different devices involving different facts and different prior art were determined. See footnote page 3 supra. Del Mar Avionics, Inc. v. Quinton Instrument Co., 5 USPQ2d 1255,1258 (CAFC 1987) ("A device not previously before the

court, and shown to differ from those structures previously litigated, requires determination on its own facts). Since the 660 Patent device was not previously before the court and since its structure and function differ from those structures and functions previously litigated, collateral estoppel does not apply and the issue of obviousness requires determination on its own facts.

4. The Tests for Obviousness Were Not Made

The courts below relied on Constant, supra to establish that the 660 Patent is invalid because "the 635 Patent reveals that every element found in the 660 Patent is also found in the 635 Patent, with the exception of the application, which recites time inversion" (B-14,15). The courts

below collaterally estopped the petitioner from relitigating the decision of the CAFC (B-15) and the CAFC denied petitioner's motion to file a supplement brief to revisit the earlier decision (A-3). Thus, the petitioner was denied any opportunity to point out that the collateral estoppel effects of the earlier case did not apply and/or to point out errors in the earlier decision. In Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 US 313, 169 USPQ 513 (1971), this Court set forth the rule that once a patent has been declared invalid via judicial inquiry, a collateral estoppel barrier is created against further litigation involving the patent, unless the patentee-plaintiff can demonstrate that he did not have a full and fair chance to litigate the validity of his patent in the earlier case. The

CAFC order (A-3) is error because it did not give petitioner the opportunity to demonstrate that he did not have a full and fair chance to litigate the validity of the 635 Patent in Constant, supra.

Rather, the differences between the 660 and 635 Patents, and obviousness, were determined not upon their own facts but upon the different facts and errors in Constant, supra. However, this Court has established that obviousness must be grounded on the four factual inquiries in Graham v. John Deere, 148 USPQ 459,467 (SCt 1966).

a. Scope and Content of the Prior Art

Section 103 applies when "the invention is not identically disclosed or described as set forth in Section 102". Under Section 102, references cannot be combined. In re Saunders, 444 F2d 599,602-03, 170 USPQ 213 (CCPA 1971). See also Studiengeselschaft

Kohle mbH v. Dart Indus., 549 FSupp 716, 216 USPQ 381 (D Del 1982) aff'd 726 F2d 724, 220 USPQ 841 (CAFC 1984)(citing Treatise). Under Section 103, the cited combination is considered as a whole not individually. Application of Fournet,357 F2d , 53 CCPA 1247 (1966)(Use of prior art teachings under this section requiring non-obvious subject matter as condition for patentability is a two-way street, available to both parties, and the court is required to evaluate references as a whole regardless of party offering references. Clearly, the combination of the Constant 635 Patent, Springer article, and Bird 651 Patent is not prior art under any subsection of Section 102. Moreover, the references taken singly are not prior art for the following reasons.

That the references taken singly are prior art because they antedate the 660

Patent is just one factor in the requirement under Section 102. The other factor is whether the "invention" was described in a reference identically (to anticipate under Section 102) or non-identically (to obviate under Section 103). In the latter case, the reference must have something in common as well as something different from the claimed invention. Indeed, the common part should teach or suggest the key element(s) of the claimed invention . In re Merchant, 575 F2d 865, 197 USPQ 785 (CCPA 1978), the court noted the difficulty in determining what in fact is prior art

> "A comparison of the claimed invention with the disclosure of each cited reference to determine the number of claim limitations in common with each reference , bearing in mind the relative importance of particular limitations, will usually yield the closest single prior art reference". Id

A comparison of the claimed invention with each reference yields the facts that, first, no reference is in the claimed preamble, second, Springer and Bird do not disclose any claimed elements (*) and, third, Constant 635 discloses all claimed elements except the key claimed element for time reverse output sequence. Thus, Springer and Bird are not prior art because they do not fall within the claimed preambles and do not disclose any element of the claimed invention. Constant 635 is not prior art because an inventor's patent cannot be used to determine obviousness of his later invention. Reading & Bates, supra.

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* Springer's RAM is not the claimed digital delay RAM. See infra. Bird's FIFO and LIFO are not the claimed time or time-reverse output sequences from the claimed digital delay RAM (FIJO). See infra.

Moreover, Section 112 par. 6, which applies here, provides that means-plus-function language in a claim shall be construed to cover the structure described in the specification and equivalents thereof. Further, Section 112 requires identity of function absent which consideration of structure is not involved. Pennwalt Corp. v. Durand-Wayland, Inc., 4 USPQ2d 1737,1739 (CAFC 1987). If the required function of time inversion is not performed exactly, Section 112 par. 6 precludes the consideration of any structure in the references taken singly. Thus, it was error for the court to construe the structures in references to cover the 660 structure. The fact that references taken singly do not perform the same function denies the possibility that these references are

of the 660 Patent disclose convolution/correlation filters and time compressors using shift registers. Constant 635 discloses a time compressor using a RAM. Springer discloses a RAM replacing a shift register and Bird 651 discloses FIFO and LIFO data inputs and outputs of a storage memory.

From the foregoing it is clear that the 660 invention evolved from and is the first disclosure of a time inversion system in a convolution/correlation filter (Fig 2 in 660 Patent). Although the court concludes that the time reversal function would be obvious (B-16), it does not show that there is any teaching or suggestion in the prior art as a whole, that would lead one of ordinary skill to make the claimed time inversion system in a convolution/correlation filter (Fig 2 in 660 Patent).

b. Differences Between Prior Art and Claims at Issue

Constant 635 teaches all claimed elements except the time reversal function. The 660 Patent teaches and claims a digital delay RAM to obtain the output at each location of the delay line after 1,2, . . . N delays in a time compression filter (Fig 2 660 Patent). In contrast, Springer and Bird obtain their outputs FIFO or LIFO, i. e. data input is read out exactly N cycles later. The claimed output is neither FIFO or LIFO since for each input the output is obtained from any location J in the delay line RAM every N cycles (first-in-J-out) in the same or time reverse sequence. Springer and Bird operate memories at the same input and output (clock) rate. This feature alone makes the Springer and Bird memories unsuitable for use in the 660 Fig 2 filter which requires

low input rates and high output rates to obtain time compression. Finally, Springer and Bird do not suggest the claimed means for shifting the RAM after each sampling interval (as would be required in Fig 2 of the 660 Patent to obtain time compression). Because Springer's and Bird's memories operate their inputs and outputs at the same clock rate, they do not need and do not suggest the key claimed means for shifting the RAM after each sampling interval.

In short, the claimed invention has combined the structures and functions of time reversal and time compression used in filters. There is no suggestion for such combination in the Constant 635, Bird 651, and Springer references or in the prior art as a whole. The claims are construed in terms of the filter shown in Fig 2 of the 660 Patent. 35 USC 112 par. 6.

Although the court concludes that the combination of references does suggest the structure and function of the 660 Patent, it gives no reason for making the claimed combination of time reversal and time compression other than that gleaned from the invention itself, and the court does not discuss where in the prior art suggests the desirability, and thus the obviousness, of making the claimed combination of a time reversal and time compression functions. Uniroyal, supra 1438-39. The court impermissibly disregards portions of the Springer and Bird references that teach away from the invention (Springer's RAM and Bird's memory operate serial-in-serial out FIFO/LIFO with inputs and outputs at the same clock rate which precludes their use in the claimed means for shifting the RAM after each sampling interval of a filter). Akzo,W.L.

Gore, supra. The court impermissibly picks random bits and pieces of the Constant 635 Patent (digital delay RAM and means for shifting the RAM after each sampling interval), Springer article (RAM replacing a shift register without FIJO and without time reversal and time compression), and the Bird 651 (FIFO/LIFO memory without FIJO and without time compression) and employs them "as a mosaic to recreate a facsimile of the claimed invention". In shourt, the court reaches its conclusion (B-16 through B-19) on the basis of references that are not prior art, that do not suggest the claimed FIJO with time compression and without showing where in the prior art there is suggested the desirability, and thus obviousness of making the claimed combination of a time reversal and time compression functions. Uniroyal, supra 1438-39.

c. Level of Skill in the Pertinent Art

In determining the level of ordinary skill in the art, the factors are (1) the inventor's educational background, (2) type of problems encountered in the art, (3) solutions previously found, (4) the speed of innovation in the art, (5) sophistication of technology, (6) educational level of active workers in the field. Environmental Designs Ltd v. Union Oil Co., 713 F2d 693,696, 218 USPQ 865,868 (CAFC 1983) cert den 464 US 1043, 224 USPQ 520 (1984). Not all above factors may be present in every case, and one or more of these or other factors may predominate in a particular case. The important consideration lies in the need to adhere to the statute, i.e., to hold that an invention would or would not have been obvious to a person of ordinary skill in the art, not to a judge, or to a layman when it was made,

or to those skilled in remote arts, or to geniuses in the art at hand. Id 697, 868-69.

The invention was developed in 1974, thus establishing a reference point for determining the level of skill in the art. 35 USC 103; see Kloster Speedsteel AB v. Crucible, Inc., 793 F2d 1565,1574, 230 USPQ 81,86 (CAFC 1986) cert den 107 SCt 882 (1987). It is important to focus on the relevant time period to avoid viewing the invention through hindsight. W.L. Gore, supra 1553,313.

Applying these factors, there is nothing in the record to determine the educational level of the inventor or of active workers in the field, factors (1) and (6) supra. The remaining factors must be determined from the pertinent art which would reasonably be considered to

contain solutions to the problem facing the inventor at the time the invention was made. Standard Oil Co. v. American Cyanamid Co., 774 F2d 448,454,227 USPQ 293,297-98 (CAFC 1985).

The common problem encountered in incorporating the claimed time reversal feature in a filter, factor (2) supra, is to operate the input and output sampling rate of the filter's time compressor at different rates. Solutions found previously, factor (3) supra, do not exist because no one was motivated or had any reason to combine the time reversal feature into a filter's time compression system. * The speed of

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* Petitioner's motive to combine the time reversal feature into a filter's time compression system was to provide a convolver (filter) having twice the time resolution of existing correlation devises (col 5 line 14-16 660 Patent)

innovation, factor (4) supra, did not exist because no one in the prior art made a time inversion system for use in a time copression filter. Finally, while the sohistication of the technology, factor (5) supra, was high in the area of time compression filters, the filter art had not reached the sophistication to use time reversal in a time compression filter. It is reasonable therefore to assume that the level of skill in the pertinent art at the time the invention was made in 1974 while high in areas of time compression filters was nevertheless non-existent in the invention area of combining a time reversal feature into time compression filters (Fig 2 660 Patent).

The court's conclusion that "The level of ordinary skill in the art is that of an engineer with a BSEE who has had several years experience in the field of digital electronics" (B-14) is error because it is

not based upon any factual inquiry of the factors (1)-(6) supra but rests solely on the unsupported statement of AMD's expert witness (Frieden decl. 1 par 2 DN 69), a person of ordinary skill in the art in 1989 and, therefore, not adhering to the statute. Environmental Designs, supra 697,868-69. Moreover FRE 702 provides for use of expert testimony when it will "assist the trier of fact to understand the evidence or to determine a fact in issue". Here, expert Frieden provides no evidence to determine the level of skill at the time the invention was made in 1974 but only provides a statement as to what he thinks the level of skill is in 1989 through hindsight. Railroad Dynamics, Inc. v. A.Stucki Co., 218 USPQ 618 (ED Pa 1983) aff'd 220 USPQ 929 (CAFC 1984)(Burden of patent challenger is to prove facts supporting defenses,

not to prove legal conclusion of patent invalidity sought by these defenses).

d. Objective Evidence

The fourth consideration in an obviousness inquiry involves the study of objective evidence, so called "secondary considerations". These secondary considerations must be considered before a decision on obviousness is reached. Stratoflex, Inc. v.Aeroquip Corp., 713 F2d 1530,1538, 218 USPQ 871,879 (CAFC 1983). Furthermore, secondary considerations may be the most revealing evidence available, Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F2d 281,306, 227 USPQ 657,674-75 (CAFC 1985) cert den 475 US 1017 (1986); Custom Accessories, Inc. v. Jeffry-Allan Ind., 807 F2d 955,960, 1 USPQ2d 1196,1199 (CAFC 1986); W.L. Gore, supra 1555,314, and are entitled to great weight when the evidence is strong.

Simmons Fastener Corp. v. Illinois Tool Works, Inc., 739 F2d 1573,1576, 222 USPQ 744,747 (CAFC 1984) cert den 471 US 1065 (1985). See also Panduit Corp. v. Dennison Mfg Co., 810 F2d 1561,1569, 1 USPQ2d 1593, 1598 n.13 (CAFC 1987) cert den 107 SCt 2187 (1987)("In appraising an inventor's contribution to the art . . . the most reliable test is to look at the situation before and after it appears" quoting Safety Car Heating & Lighting Co. v. General Electric Co., 155 F2d 937,939, 69 USPQ 401,402 CA2 1946 L.Hand,J.).

Petitioner's contribution to the art is that the claimed time reversal feature was combined into a time compressor filter (Fig 2 660 Patent) to provide for high quality filters (col 5 lines 1-25 660 Patent). *

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* The Springer and Bird references cannot be applied to a time compression filter

The court's conclusion that "The objective evidence does not support a finding of non-obviousness" (B-19) is error because it is premature. The objective evidence cannot be established before the infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices is determined. Clearly, if AMD infringes the 660 Patent then such evidence would be entitled to great weight (W.L. Gore, supra) and must be considered before a decision on obviousness is made (Stratoflex, supra).

i. There is an Issue Between the Parties as to Infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 Devices

The court's order filed 27 January, 1989 (B-2) held that the 660 Patent was not infringed by AMD's 29300 and 29500 systems, and the court's order filed 16 March, 1989 (B-10) held that the 660

Patent is invalid under 35 USC 103. The court's order filed 4 April, 1989 (B-21) held that the petitioner's motion for infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices is determined by "previous orders entered in this action" (B-22). It is clear that petitioner's motion for infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices was not determined on the merits since the 660 Patent was found to be invalid by the court.

ii. <u>The Secondary Evidence of Infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 Devices was Not Considered Before the Decision on Obviousness of the 660 Patent was Reached</u>

The 660 Patent was held invalid under 35 USC 103 (B-10) before the secondary evidence of the infringement of the 660 Patent by AMD's 7910/11 and 79C12/14

devices was resolved (since commercial success would be established if AMD's products were shown to infringe the 660 Patent). Stratoflex, supra 1538,879 (Secondary considerations must be considered before a decision on obviousness is reached).

iii. The court's Judgement that the 660 Patent is Invalid Before a Full Adjudication of the Infringement of that Patent by AMD was Made is Error and Deprives Petitioner's Due Process

Since the court did not fully adjudicate the infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices, there is no infringement adjudication on appeal to protect the 660 Patent's validity when that patent in fact is not infringed by AMD. Advance Transformer, supra 1603 (Appellate court's determination that patent was

not infringed renders moot dispute as to patent's validity, and the federal district court's holding that patent invalid is therefore vacated). The absence of the full adjudication of the infringement of the 660 Patent by AMD by the court deprives petitioner's due process.

The test for obviousness under 35 USC 103 must include the objective evidence (B-13,14). Since commercial success of the invention would be established if AMD's products infringe the 660 Patent, the determination of infringement of the 660 Patent by AMD's 7910/11 and 79C12/C14 devices is a material fact which must be considered before a decision on obviousness is reached. Stratoflex, supra.

The court's judgement that the 660 Patent is invalid before a full adjudication of that patent by AMD's 7910/11 and 79C12/14 devices denies petitioner a

hearing for infringement on merits to show that in fact the 660 Patent is infringed by AMD's 7910/11 and 79C12/14 devices and to thereby establish commercial success that makes the invention not obvious. Vlandis v. Kline, 412 US 441 (1973) (Students not given the opportunity to show that in fact they have become residents); Cleveland Board of Education v. LaFleur, 414 US 632 (1974)(Woman not given the opportunity to show that pregnancy does not incapacitate as a teacher).

III. The 458 Patent is Infringed by AMD's 9568, 9518 and 8068 devices

AMD infringes the 458 Patent because the 9568,9518,8068 devices each compute the encryption algorithm given in the Federal Register 17 March, 1975 in the identical or equivalent means described in elements 4 and 6b of Fig 5 of the 458 Patent. For identity of structure and function see EXHIBITS 1,2,3,4,5,6 in DN 82.

Claims of the 458 Patent are means plus function claims. The last paragraph of 35 USC 112 directs that a means plus function claim "shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

The 9568,9518,8086 devices infringe claims 17,19,22,23,27,30 of the 458 Patent because every function of the claimed combination is performed by each accused

device, the structures performing those functions being identicals or equivalents of the structures described in the 458 Patent, literally under 35 USC 112 paragraph 6. Pennwalt, supra.

The court's order holding that the 458 Patent is not infringed by the 9568, 9518,8068 devices (B-21) is error because, first, claims require "memory means having storage locations for n words" and, second, claims require "stored outputs S_n,K_n representing at least one of delayed,encrypted, and decrypted signals K,S". The disclosure in the 458 Patent specifies "signals S_n,K_n where n=1,2,...N appear as inputs to algorithm computer 6b in RAM 30" (col 8 lines 19-20). The 9568, 9518, 8068 devices have signal K_n where n=1 and signals S_n,K_n appear as inputs to the algorithm computer. See EXHIBITS 1,2,3 in DN 82.

The court's finding that "Mr. Constant

is estopped from contending that the 458 Patent does not involve a memory device which stores more than one word" (B-26,27) is without merit since, once literal infringement is found, the doctrine of file wrapper estoppel is inapplicable. Loctite Corp. v. Ultraseal Ltd., 781 F2d 861,870, 228 USPQ 90,95 (CAFC 1985): Fromson v. Advance Offset Plate, Inc., 720 F2d 1565, 1571, 219 USPQ 1137,1141 (CAFC 1983). An analysis of the file wrapper estoppel doctrine, as well as purposes it is intended to serve illustrates the soundness of this conclusion.

File wrapper estoppel is an equitable doctrine designed to limit a patentee's use of the doctrine of equivalents. Exhibit Supply Co. v. Ace Patents Corp., 315 US 126, 136, 52 USPQ 275,279 (1942); Thomas & Betts Corp. v. Litton Systems, Inc., 720 F2d 1572,

1579-80, 220 USPQ 1,5-6 (CAFC 1983); Loctite, supra at 870; Hughes Aircraft Co. v. United States, 717 F2d 1351, 219 USPQ 473 (CAFC 1983); Caterpillar Tractor Co. v. Berco,SPA, 714 F2d 1110,1115, 219 USPQ 185,187 (CAFC 1983). By invoking the doctrine of equivalents, a patentee attempts to broaden the scope of his patent beyond the literal language of its claims. Graver Mfg Co. Inc. v. Linde Co., 339 US 605,608, 85 USPQ 328, 330 (1950); Hughes Aircraft Co., supra at 1361,480. To counter that thrust, the doctrine of file wrapper estoppel prevents the patentee from extending the scope of his patent to subject matter he previously surrendered. Exhibit Supply, supra at 136, 279; Hughes Aircraft Co., supra at 1362,48.

The doctrine of file wrapper estoppel is not applicable, however, where literal infringement has been found and the patentee

is, therefore, not relying upon the doctrine of equivalents. See e.g., Hughes Aircraft Co., supra at 1361,480 ("The doctrine of equivalents comes into play only when actual literal infringement is not present"). The doctrine of file wrapper estoppel does not apply in the present case because literal infringement is present.

The court's finding that "the 458 Patent requires that signal K be delayed, encrypted, or decrypted before being placed in the crypto means" (B-28) is incorrect since Fig 7 in the Patent clearly requires that signal K (input to RAM 40) be stored and delayed in RAM 40 (col 8 lines 11-15 disclose RAM 40 is a storing RAM; col 9 lines 59-66 disclose that RAM performs the function of a delay line) before signal K_n (output from RAM 40) is placed in the crypto means RAM 30. The

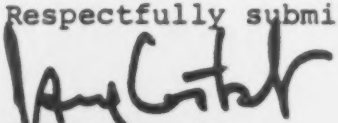
correct statement therefore is "the 458 Patent requires that signal K_n be delayed, encrypted, or decrypted before being placed in the crypto means". This requirement is always met since signal K is always encrypted or decrypted since signal K is the key for a clear or cipher signal S (col 8 lines 14-15) it may be enciphered or deciphered before or after it is placed in RAM 40 (col 8 lines 34-35 disclose RAMs 30 and 40 may be identical enciphering or deciphering RAMs). In either case, signal K_n, as claimed, represents "at least one of delayed, encrypted, and decrypted signal K". As claimed, accused devices store the cryptographic key in a second memory with n=1 word location (single stage delay register) the output of which represents at least one of a delayed, encrypted or decrypted signal K_1.

CONCLUSION

The petition should be granted because the court of appeals judgement (A-2) is in conflict with the decisions of the same and of other courts of appeals, and with the applicable decisions of this Court, on the same matter and because the court of appeals has so far departed from the usual proceedings as to call for an exercise of this Court's power of supervision.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the judgement (A-2) and order (A-3) of the United States Court of Appeals for the Federal Circuit.

Respectfully submitted



11/27/89

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

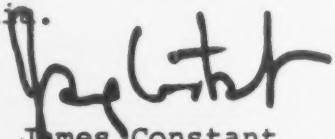
CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT and APPENDIX were served on the respondent by mailing first class Three (3) true copies to it on 27 November, 1989 addressed as follows

Skjerven, Morrill, MacPherson,
Franklin & Friel
25 Metro Drive, Suite 700
San Jose, California 95110

I declare under penalty of perjury that the foregoing is true and correct.

Executed on 27 November, 1989 at Claremont, California.



James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

89-881

Supreme Court, U.S.
FILED
NOV 28 1989
JOSEPH F. SPANIOL, JR.
CLERK

No. _____

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1989

JAMES CONSTANT

Petitioner,

v.

ADVANCED MICRO-DEVICES, INC.

Respondent.

A P P E N D I X

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

Pro se petitioner

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and holding that the 458 patent is not infringed by AMD

B-30 District Court Judgement filed 4 April, 1989 adjudicating that the 351 and 458 patents are not infringed by AMD, that the 660 patent is invalid, and dismissing petitioner's counterclaims with prejudice

A P P E N D I X A

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

89-1432

ADVANCED MICRO DEVICES, INC.,

Plaintiff-Respondent

v.

JAMES CONSTANT

Defendant-Petitioner

JUDGEMENT

ON APPEAL from the U.S. District Court, Northern District of California in CASE NO 88-20201-RPA. This CAUSE having been considered, it is ORDERED and ADJUDGED: Per Curiam (NIES, Circuit Judge, SMITH, Senior Circuit Judge, and NEWMAN, Circuit Judge): AFFIRMED. See Fed.Cir.R.36

ENTERED BY ORDER OF THE COURT

DATED: Oct 5 1989

Francis X. Gindhart,

Clerk

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

89-1432

ADVANCED MICRO DEVICES, INC.,

Plaintiff-Respondent

v.

JAMES CONSTANT,

Defendant-Petitioner.

ON MOTION

Before FRIEDMAN, Circuit Judge.

O R D E R

Upon consideration of the motion of James Constant for leave to file a 30-page supplement to the 49-page brief already filed,

IT IS ORDERED THAT:

The motion is denied. The total length of Constant's brief may be no longer than 50 pages.

6/26/89 Daniel M. Friedman

Circuit Judge

A P E N D I X B

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Jan 27, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff,

v.

JAMES CONSTANT,

Defendant.

ORDER GRANTING PLAINTIFF'S MOTION FOR SUMMARY ADJUDICATION AND DENYING MOTION FOR SANCTIONS AND DENYING DEFENDANT'S MOTIONS FOR SUMMARY JUDGEMENT AND SUPPRESSION OF TESTIMONY

I. INTRODUCTION

The Court has received, read, and considered the papers submitted by counsel and by Mr. Constant, both in support of and in opposition to, their respective motions. The Court also heard oral argument on all motions. GOOD CAUSE appearing therefore, the Court finds and orders as follows.

Advanced Micro Devices, Inc. (hereinafter referred to as "AMD") filed a motion for summary adjudication and a motion for Rule 11 sanctions. Mr. Constant responded to these motions, and filed his own motions for summary judgement and for the suppression of the use of his deposition testimony. Each of these motions is discussed separately below.

II. DISCUSSION

A. Motion for Summary Adjudication

AMD directs its motion for summary adjudication to two (2) patents-in-suit: Patent No. 4,006,351 (hereinafter referred to as "351") and Patent No. 4,080,660 (hereinafter referred to as "660") and contends that no products manufactured and/or sold by AMD infringe either of these patents. Constant has failed to present any evidence that either or both of hus patents have actually been infringed.

Accordingly, plaintiff's motion for summary adjudication of issues is hereby GRANTED. The following facts are established as a matter of law:

1. AMD does not sell any computer systems based on parts from its 29300 and 29500 families, but instead sells only individual parts which its customers use to create computer systems to the customer's specification.

2. A large number of possible computer systems could be built out of parts from AMD's 29300 and 29500 families. Such computer systems could be programmed to perform an infinite number of possible operations.

3. The 351 patent is infringed only by devices or systems which constitute a recursive filter implemented as a matched clutter filter.

4. None of the parts from AMD's 29300 and 29500 families constitutes a recursive

filter implemented as a matched clutter filter.

5. AMD has never created a system out of parts from its 29300 and 29500 families which constitutes a recursive filter implemented as a matched clutter filter, nor has AMD ever programmed such a system in such a manner that it operates as a recursive filter implemented as a matched clutter filter.

6. There is no evidence that any AMD customer has ever used parts from AMD's 29300 and 29500 families to create a computer system which constitutes a recursive filter implemented as a matched clutter filter.

7. AMD has never encouraged any of its customers to use parts from its 29300 and 29500 families to create any system which constitutes a recursive filter implemented as a matched clutter filter.

8. None of the parts from AMD's 29300 and 29500 families includes the elements claimed in the 660 patent.

9. AMD has never used parts from its 29300 and 29500 families to create a system such as that claimed in the 660 Patent.

10. AMD has never programmed a system built out of parts from its 29300 and 29500 families in such a manner that such system operates in the manner claimed in the 660 Patent.

11. There is no evidence that any AMD customer has ever used parts from AMD's 29300 and 29500 families to create a computer system that operates in the manner claimed in the 660 Patent.

12. AMD has never encouraged any of its customers to use parts from its 29300 and 29500 families to create any system that operates in the manner claimed in the 660 Patent.

13. AMD does not directly, contributorily or through inducement infringe the claims of the 351 Patent.

14. AMD does not directly, contributorily or through inducement infringe the claims of the 660 Patent through making, using or selling products from the 29300 and 29500 families, through making, using or selling systems based on such parts, or through encouraging its customers to make any infinging system from such parts.

15. At the trila of this Action, defendant shall be precluded from introducing evidence relating to (1) infringement of the 351 Patent; and (2) infringement of the 660 Patent by products from the 29300 and 29500 families.

B. Motion for Sanctions

Plaintiff's motion for sanctions against defendant Constant is hereby DENIED. The Court finds that defendant acted with a

reasonable, good faith belief that his actions were justified under the law.

C. Motions for Summary Judgement

Based upon the foregoing, the Court hereby DENIES defendant's motion for summary judgement based upon the infringement of Patent Nos. 351 and 660.

D. Motion for Suppression of Testimony

Apparently, the parties have resolved their dispute with respect to the deposition testimony of Mr. Constant. Mr. Constant shall make any substantive changes he wishes made to his deposition. Said changes shall be attached to Mr. Constant's original deposition, but shall not supercede or replace the original deposition testimony.

Accordingly, plaintiff need not incur any expense in changing the deposition testimony of Mr. Constant. AMD may still rely upon Mr. Constant's original deposition testimony and such testimony may be used in support of AMD's motion for summary adjudi-

cation. AMD may also, upon proper notice, re-depose Mr. Constant.

III. CONCLUSION

Based upon the foregoing, the Court hereby GRANTS plaintiff's motion for summary adjudication and DENIES plaintiff's motion for sanctions. The Court also DENIES defendant's motions for summary judgement. Defendant's motion for the suppression of deposition testimony is moot and is, therefore, DENIED.

IT IS SO ORDERED.

DATED: January 27, 1989

ROBERT P. AGUILAR
United States District
Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Mar 16, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff,

v.

JAMES CONSTANT

Defendant.

ORDER GRANTING PLAINTIFF'S MOTION FOR SUMMARY ADJUDICATION AND DENYING MOTION FOR SANCTIONS

The Court has received, read, and considered plaintiff's motion for summary adjudication that Patent No. 4,080,660 (hereinafter referred to as the "660") is invalid, and the opposition thereto. The Court has also received, read, and considered both plaintiff's and defendant's requests for sanctions, pursuant to Rule 11 of the Federal Rules of Civil Procedure.

Oral argument was heard in this matter on Friday, March 10, 1989. GOOD CAUSE appearing therefore, the Court finds and orders as follows.

I. FACTUAL BACKGROUND

This matter is once again before the Court based upon a challenge to one of Mr. Constant's patents, the 660 Patent. Advanced Micro Devices, Inc. (hereinafter referred to as "AMD") contends that the 660 Patent is invalid for obviousness, based upon an earlier Federal Circuit holding, which found that Patent No. 3,950,635 (hereinafter referred to as the "635" Patent), also owned by Mr. Constant, was invalid for obviousness.

The 635 Patent discloses the use of random access memories (RAMs) in place of shift registers for use in a matched filter or correlator. The Federal Circuit held that Mr. Constant had obtained the idea for replacing shift registers with RAMs

from an article written by John Springer entitled "High Speed Shift Registers use TTL RAMs and Counters to do All the Shifting". This article was published in 1973. The article was found to have disclosed every element of the invention claimed in the 635 Patent, except the specific filter application contained in the Patent.

AMD asserts that the claims of the 660 Patent are virtually identical to those claims contained in the 635 Patent, with a few minor exceptions. The 660 Patent is a digital time scale inversion. Mr. Constant maintains that the two patents are significantly different. Both sides request that sanctions be imposed against the other, pursuant to Rule 11 of the Federal Rules of Civil Procedure.

II. LEGAL STANDARDS

Under Title 35 of the United States Code, Section 103, a patent may not be obtained if "the subject matter as a whole would have beed obvious at the time the invention was made to a person having ordinary skill in the art . . .". The Federal Circuit has held that a finding of obviousness must be supported by clear and convincing evidence sufficient to overcome a patent's presumption of validity. Constant v. AMD, 848 F.2d 1560, 1570 (Fed. Cir. 1988).

In addition, in DMI, Inc. v. Deere & Co., 802 F.2d 421,425 (Fed. Cir. 1986), the Federal Circuit held that an analysis of obviousness must include the following four elements:

1. Scope and content of the prior art;
2. Differences between the claimed invention and the prior art;
3. Level of ordinary skill in the art; and

4. Objective evidence of non-obviousness.

In reviewing the scope and content of the prior art, the Court can look not only to the Springer article, but also to the 651 Patent (discussed below), which demonstrates the use of LIFO and FIFO accounting methods. The level of skill in the art in this case is that of an engineer with a Bachelor of Science in Electrical Engineering who has had several years of experience in the field of digital electronics.

The objective evidence which is relevant to obviousness includes commercial success, long-felt but unsolved needs, failure of others, copying, and unexpected results.

III. DISCUSSION

An examination by the Court of both the 660 Patent and the 635 Patent reveals that every element found in the 660 Patent

is also found in the 635 Patent, with the exception of the application, which recites time inversion. The time inversion feature is simply the fact that data input in one order can be output in the same order or in a different order. In other words, data can be output in either a LIFO or FIFO mode.

While Mr. Constant admits that the only difference between the 660 Patent and the 635 Patent is the specific application, it is clear that Mr. Constant attempts to address the arguments raised before the Federal Circuit and seeks to have this Court "overturn" the Circuit's decision. However, the decision of the Federal Circuit is final and may only be appealed to the appropriate court, which is not this Court. Mr. Constant is collaterally estopped, as is AMD, from relitigating the decision of the Circuit. 1B J. Moore, Moore's Federal Practice, 441(2) at p.

725 (1988).

The problem now faced by the Court is determining whether or not time inversion, the only distinguishing feature between the 660 Patent and the 635 Patent, is an obvious concept. However, the Court's task is simplified by production of U.S. Patent No. 3,553,651 (hereinafter referred to as the "651" Patent), which shows the use of LIFO versus FIFO modes in a memory device. Mr. Constant's assertion that, "the 660 Patent is the first patent ever granted for a time inverter" does not appear to be true.

Based upon the foregoing, the Court hereby finds as follows:

1. There is clear and convincing evidence that all claims of the 660 Patent are invalid under 35 USC 103, because, considered as a whole, the invention disclosed in that Patent would have been obvious at the time the application was

filed to a person having ordinary skill in the art.

2. The art involved in the 660 Patent is that of digital logic systems and methods which perform signal processing. The level of ordinary skill in such art is that of an engineer with a B.S.E.E. who has had several years of experience in the field of digital electronics.

3. The prior art includes an article entitled "High-speed shift registers use TTL RAMs and counters to do all the shifting" published in 1973 by John Springer. The prior art also includes U.S. Patent No. 3,553,651 (hereinafter referred to as the "651" Patent). The patent discloses the concept of using memory devices to perform digital time scal inversion, otherwise known as "First In, First Out"(FIFO) and "Last In First Out" (LIFO) operations.

4. The Springer article discloses every element contained in claims One and Four of the 660 Patent, except for the specific application in which the invention is to be used.

5. In light of the Springer article and the 651 Patent, it would have been obvious to one skilled in the art to substitute RAMs for shift registers in the specific application disclosed in the 660 Patent ("Digital Time Scale Inversion of Signals").

6. Considering Claims One and Four of the 660 Patent as a whole, the invention disclosed in such claims would have been obvious to one of ordinary skill in the art. Therefore, such claims are invalid under 35 USC 103.

7. In light of the Springer article and the 651 Patent, it would have been obvious to use the following devices in

the system and method described in Claims One and Four of the 660 Patent: TTL, CCD, ECL, DELTIC circuit. Considering Claims Two, Three, and Five of that Patent as a whole, the invention disclosed in such claims would have been obvious to one of ordinary skill in the art. Threfore, such claims are also invalid under 35 USC 103.

8. The objective evidence does not support a finding of non-obviousness. The invention claimed in the 660 Patent has not been commercially exploited in any way. There is no evidence that that Patent has been copied, that it filled a long-felt need, or that the invention claimed led to unexpected results.

In addition, the Court hereby DENIES AMD's request for sanctions. The Court also DENIES Mr. Constant's request for sanctions, to the extent that such request was incorporated into Mr. Constant's opposition

memorandum. The Court also points out to Mr. Constant that his in limine motions will be addressed at trial and that any and all discovery disputes must be brought to the attention of Magistrate Trumbill before they may be filed before this Court.

IV. CONCLUSION

Based upon the foregoing, the Court hereby GRANTS plaintiff's motion for summary adjudication and DENIES plaintiff's request for sanctions. The Court also DENIES Mr. Constant's request for sanctions.

IT IS SO ORDERED

DATED: March 16, 1989

ROBERT P. AGUILAR

United States District Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Apr 4, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff,

v.

JAMES CONSTANT,

Defendant.

ORDER GRANTING PLAINTIFF'S MOTION FOR SUMMARY JUDGEMENT AND DENYING DEFENDANT'S MOTIONS AND ENTERING FINAL JUDGEMENT

The Court has received, read, and considered both plaintiff's and defendant's motions for summary judgement. Defendant moved for summary judgement on Patent Nos. 4,107,458 (hereinafter referred to as the "458" Patent) and 4,080,660 (hereinafter referred to as the "660" Patent) and also filed a motion for summary judgement on validity issues and sanctions. Plaintiff

opposed all motions and filed its own cross-motion for summary judgement regarding the 458 Patent. The Court submitted all motions on the papers, without oral argument, at the request of defendant Constant. GOOD CAUSE appearing therefor, the Court finds and orders as follows.

The Court previously granted plaintiff's motion for summary judgement with respect to two of the three patents involved in this action, Patent Nos 4,006,351 (hereinafter referred to as the "351" Patent) and 4,080,660 (hereinafter referred to as the "660" Patent). Therefore, in so far as defendant's motions relate to the 351 and 660 patents, the Court refers defendant to the previous Orders entered in this action.

The only remaining patent in this action, then, is the 458 patent. Both plaintiff and defendant have filed a motion for summary judgement with respect to the 458

patent, with plaintiff alleging that the AMD products do not infringe the patent, while defendant argues that the products do infringe the patent. Each of the parties' arguments are discussed below.

The 458 patent entitled "Cipher Computer and Cryptographic System", enables words to be stored in a memory device. The dispute in this motion arises mainly whether or not AMD's accused products store one word, as in prior art relied on by Mr. Constant to distinguish the 458 Patent, or store more than one word, as in the 458 Patent.

Mr. Constant alleges that AMD's 9518,9568 and 8068 products infringe Claims 17,19,22,25,27, and 30 of the 458 Patent. Claims 17 and 25 are independent claims, and the remaining claims are dependent upon Claims 17 and 25. Each of the dependent claims adds an element to the independent

claim. Therefore, if AMD's products are lacking an element recited in Claims 17 and 25, they cannot infringe any of the claims. AMD asserts that its products do not infringe claims 17 and 25 since the products do not contain at least three of the elements recited in each Claim.

First, AMD contends that Claims 17 and 25 of the 458 Patent require that the first memory means store more than one word. Second, AMD asserts that the second memory means must also store more than one word. Finally, AMD argues that AMD's products do not delay, encrypt or decrypt signal K. Mr. Constant submits that the number of words in the claims is unrestricted and that the AMD products represent "one of delayed, encrypted, and decrypted signals".

AMD correctly states that, under the doctrine of file wrapper estoppel, Mr.

Constant is bound by the interpretation of his claims which he made in order to distinguish the prior art. Townsend Engineering Co. v. Hitec Co., Ltd. 829 F2d 1086,1090 (Fed. Circ 1987). During Mr. Constant's prosecution of the 458 Patent, Mr. Constant distinguished the prior art, in part, by arguing that the prior art shows memory means which stores only a single word, while his claims for the memory means store more than one.

Mr. Constant responds to this argument by stating that the explanation that he gave, while correct as stated by AMD, was with regard to the amendment to the patents, dated January 24, 1978, which was refused by the Patent Examiner. This is correct. However, Mr. Constant neglects to inform the Court that he then submitted another amendment, dated March 2, 1978,

which added an additional feature, but kept all other language from the January 24, 1978, amendment the same.

Therefore, while Mr. Constant is correct in contending that the Court should ignore his allegations with respect to the January amendment, the identical language is contained in the March amendment and the Court cannot simply ignore that language. Nor is it necessary for AMD to show that the patent examiner actually relied on this particular distinction in granting the 458 Patent. Norwood v. Ehrenreich Photo-Optical Industries, Inc., 322 F. Supp. 898,904 (C.D. Cal. 1970).

Therefore, the Court finds that, under the doctrine of file wrapper estoppel, Mr. Constant is estopped from contending that the 458 patent does not involve a memory device which stores

more than one word. With respect to this issue, then, the Court hereby GRANTS plaintiff's motion for summary judgement.

In addition, Mr. Constant points out that AMD admits storing signal K, but that AMD denies that signal K is delayed, encrypted, or decrypted. This is correct. However, Mr. Constant asserts that the act of delaying is met by outputting signal K from the key register and then inputting signal K. In other words, there is a time difference in inputting and outputting signal K and that time difference, Mr. Constant asserts, is the "delay".

AMD argues, through the declaration of one of its employees, Mr. Sudhir Bhatnagar, that this delay is not sufficient, since the claims of the 458 Patent require that signal K be read into the device, and then delayed, encrypted, or decrypted. Mr. Bhatnager declares that merely storing signal K is not

sufficient to meet the requirement that the signal be delayed, encrypted or decrypted.

Based upon the foregoing, the Court finds that the 458 Patent requires that signal K be delayed, encrypted, or decrypted before being placed in the crypto means, while the accused products merely store signal K. Therefore, the Court GRANTS plaintiff's motion for summary judgement with respect to said element.

In sum, the Court hereby GRANTS plaintiff's motion for summary judgement regarding infringement of the 458 Patent and DENIES each and every motion by defendant for summary judgement, as well as defendant's request for sanctions. Since the Court had previously ruled that the accused AMD products do not infringe U.S. Patent No. 4,006,351 and that U.S. Patent No. 4,080,660 is invalid, the

Court enters final judgement in this matter as follows:

1. U.S. Patents 4,006,351 and 4,107,458 are not infringed by AMD and that U.S. Patent 4,080,660 is invalid, and,

2. all defendant's counterclaims are dismissed with prejudice.

IT IS SO ORDERED

DATED: April 3, 1989

ROBERT P. AGUILAR

United States District Judge

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

No. C-88-20101-RPA

Filed Apr 4, 1989

ADVANCED MICRO DEVICES, INC.,
a Delaware Corporation,

Plaintiff

v.

JAMES CONSTANT,

Defendant.

JUDGEMENT

Pursuant to the Order Granting Plaintiff's Motion for Summary Judgement signed April 3, 1989, Judgement is HEREBY ENTERED for Plaintiff.

IT IS SO ORDERED

DATED: April 3, 1989

ROBERT P. AGUILAR

United States District Judge

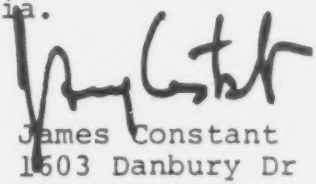
CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT and APPENDIX were served on the respondent by mailing first class Three (3) true copies to it on 27 November, 1989 addressed as follows

Skjerven, Morrill, MacPherson,
Franklin & Friel
25 Metro Drive, Suite 700
San Jose, California 95110

I declare under penalty of perjury that the foregoing is true and correct.

Executed on 27 November, 1989 at Claremont, California.



James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

(3)

No. 89-881

Supreme Court, U.S.
FILED
DEC 27 1989
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

Supreme Court of the United States

October Term, 1989

ADVANCED MICRO-DEVICES, INC.,

Respondent,

vs.

JAMES CONSTANT,

Petitioner.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

ANTHONY de ALCUAZ
SKJERVEN, MORRILL, MacPHERSON,
FRANKLIN & FRIEL
25 Metro Drive, Suite 700
San Jose, California 95110
(408) 283-1222

Attorneys for Respondent
Advanced Micro-Devices, Inc.

Batavia Times Publishing Co.
Batavia, N.Y. (716) 344-2800

Questions Presented for Review

1. Whether the manufacture, use and sale of components which could possibly be assembled and programmed to infringe a claim, but which have never been assembled and programmed to infringe, may support a finding of direct infringement, contributory infringement or inducement of infringement.

2. Whether a determination that certain of AMD's products do not infringe the '660 Patent precludes consideration of the validity of that patent when Petitioner contended that other AMD products also infringed the '660 Patent.

3. Whether the District Court properly determined that the doctrine of collateral estoppel prevented Constant from relitigating the decision of the Central District regarding his '635 Patent, which decision was affirmed by the Federal Circuit, and as to which decision Constant's petition for a writ of certiorari was denied.

4. Whether the District Court properly considered the Springer and Bird references to be prior art against the '660 patent given their prior publication dates and obvious relevance to the subject matter of the '660 patent.

5. Whether the District Court properly determined that the level of skill in the art is that of an engineer with a Bachelor of Science degree in electrical engineering and several years of experience given that the only evidence submitted on this issue supports this finding.

6. Whether the District Court properly determined that the '660 patent was invalid for obviousness in light of prior art which disclosed the claimed invention.

7. Whether the District Court properly determined that no evidence of commercial success existed which would support a finding of nonobviousness in light of Constant's failure to submit any such evidence.

8. Whether the District Court erred in determining that the '660 patent was invalid without first conducting a trial upon the issue of AMD's infringement of that patent.

9. Whether the District Court's failure to conduct a trial concerning the infringement of a patent which had previously been found to be invalid denied Petitioner due process of law.

10. Whether the District Court properly construed the claims of the '458 patent in a manner consistent with the construction urged by Constant during prosecution of the patent.

11. Whether the District Court properly found that the claims of the '458 patent contain limitations not included in AMD's products.

12. Whether the questions presented for review are appropriate for review on writ of certiorari when they are not novel or important questions and address only issues of concern to the parties.

Rule 28.1 Statement

Advanced Micro Devices, Inc. has no parents, subsidiaries or affiliates required to be listed pursuant to Rule 28.1. All parties are listed in the caption.

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United States Court of Appeals
for the Federal Circuit

No. 88-1101

James Constant v. Advanced Micro-Devices, Inc., *et al.*

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No. 88-1196

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Advanced Micro-Devices, Inc. v. James Constant

Supreme Court of the United States:

No. 88-308

James Constant v. Advanced Micro-Devices, Inc., *et al.*

No. 88-1356

James Constant v. Advanced Micro-Devices, *et al.*

No. 88-1933

James Constant v. Advanced Micro-Devices, *et al.*

IN THE

Supreme Court of the United States

October Term, 1989

No. _____

ADVANCED MICRO-DEVICES, INC.,
Respondent,

vs.

JAMES CONSTANT,
Petitioner.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Opinion Below

The United States Court of Appeals for the Federal Circuit affirmed the judgment of the United States District Court for the Northern District of California without opinion. (Petitioner's Appendix at A-2.) The opinions of the District Court are unpublished and are set forth in Petitioner's Appendix (hereinafter "Pet. App.") at B-2 to B-30.

Jurisdiction

The judgment of the court of appeals was entered on October 5, 1989. (Pet. App. at A-2.) The petition for writ of certiorari was filed November 27, 1989. The jurisdiction of this court is invoked under 28 U.S.C. Section 1254(1).

Statement of the Case

On February 17, 1988, Mr. James Constant sued Advanced Micro-Devices, Inc. ("AMD") and six other companies in the Central District of California, alleging infringement of U.S. Patents Nos. 4,006,351, 4,080,660, and 4,107,458. AMD filed an action for declaratory relief in the Northern District of California, requesting that the court declare these patents invalid, uninfringed, and unenforceable. Mr. Constant counterclaimed in the Northern District alleging infringement. The Central District action was then dismissed as to AMD for improper venue and the Northern District action proceeded.

In his counterclaim, Constant alleged that the AMD 29300 and 29500 families of integrated circuits infringed Constant's U.S. Patents Nos. 4,006,351 and 4,080,660 (hereinafter the " '351 patent" and the " '660 patent"). On January 27, 1989, the District Court granted AMD's motion for summary judgment that the 29300 and 29500 families of integrated circuits do not infringe Constant's '660 or '351 patents.

Constant also contended that AMD's 7910/11 and 79C12/C14 devices infringed his '660 patent. On March 16, 1989, the District Court granted AMD's motion for summary judgment that the '660 patent was invalid for obviousness under 35 U.S.C. §103.

Constant also alleged that AMD's encryption processors infringe his U.S. Patent No. 4,107,458 (the " '458 patent"). In an order dated April 4, 1989, the District Court granted AMD's motion for summary judgment that the '458 patent was not infringed. On that same day the District Court entered judgment for AMD and dismissed Constant's counterclaims.

Petitioner appealed these orders to the United States Court of Appeals for the Federal Circuit, which affirmed without hearing or opinion in a judgment dated October 5, 1989. (Petitioner's App. at A-2.) Constant then filed this petition for writ of certiorari.

Summary of Argument

Petitioner has not presented this Court with any issue that merits review. Each issue turns on the analysis of facts and circumstances unique to this dispute. In essence, Petitioner requests that this Court reconsider the merits of a technologically complex patent matter which was resolved correctly by the District Court and reviewed and affirmed correctly by the Federal Circuit. The issues raised are neither special nor important and are of concern only to the parties.

ARGUMENT

I.

The District Court properly determined that the 29300 and 29500 families of integrated circuits do not infringe Constant's '660 and '351 patents.

The District Court found that Constant's '351 patent claims were limited to recursive filters implemented as a matched clutter filter. (Pet. App. at B-4.) The District Court found that there was no evidence that AMD or any AMD customer had ever used any part from the 29300 or 29500 family in a system which constitutes a recursive filter implemented as a matched clutter filter and that AMD had never encouraged such use. (Pet. App. at B-4 to B-5.) Therefore, the court concluded that AMD does not infringe the '351 patent. (Pet. App. at B-7.)

Similarly, the District Court found that neither AMD nor its customers had ever used parts from AMD's 29300 or 29500 families in a system that operates as claimed in the '660 patent and that AMD had never encouraged such use. (Pet. App. at B-6.) Thus, the District Court concluded that AMD's manufacture, test and sale of these devices did not infringe the '660 patent. (Pet. App. at B-7.)

Constant argues that selling disassembled unprogrammed integrated circuits having a multitude of noninfringing uses constitutes infringement, if the integrated circuits could *conceivably* be assembled and programmed to infringe. (Petition at 18-19.) Constant raises similar arguments concerning inducement of infringement and contributory infringement. Thus, the question presented is whether the manufacture, use and sale of components which *could* possibly be assembled

and programmed to infringe a claim, but which have *never* been assembled and programmed to infringe, constitutes direct infringement, contributory infringement, or inducement of infringement.

A. The Standard Review and the Evidence Below.

The grant of summary judgment below was proper unless Constant can demonstrate that there is sufficient evidence in the record for a jury to return a verdict for him. If his evidence is merely colorable, or is not significantly probative, summary judgment was proper. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249-250 (1986); *Avia Group Intern., Inc. v. L.A. Gear California*, 853 F.2d 1557, 1560 (Fed. Cir. 1988). "[M]ere denials or conclusory statements in briefs do not create a dispute regarding a material fact." *Barmag Barmer Maschinen fabrik AG v. Murata Mach. Ltd.*, 731 F.2d 831, 836 (Fed. Cir. 1984).

Constant has not brought *any* evidence before this court. The Petitioner's Appendix contains only the opinions below. Constant relies entirely on "conclusory statements" in his brief to support his assertion of error.

If reference is made to the record below, that record indicates that AMD and Constant agree on the following facts:

1. AMD manufactures, among other things, the 29300 and 29500 families of integrated circuits. Devices from these families can be assembled and programmed to perform a *nearly infinite* number of functions. (Appellee's Fed. Cir. App. page 145.)

2. For purposes of the summary judgment motion, AMD stipulated that its products *could* also be assembled to perform the functions claimed in Constant's patents. (Appellee's Fed. Cir. App. page 180.)

3. Nobody has ever assembled and programmed these products in the manner claimed in the '660 or '351 patent. Declaration of Philip Freidin in Support of Advanced Micro Devices' Motion for Summary Adjudication of Issues and for Sanctions Under Rule 11. (Appellee's Fed. Cir. App. pages 145, 146.) Constant Deposition, 29:15-32:12, 42:2-26. (Appellee's Fed. Cir. App. pages 159-163.)

B. The District Court Applied the Proper Rule of Law in Holding Constant's '351 and '660 Patents Not Infringed.

The Federal Circuit has held that "infringement can occur only when the claimed combination has been assembled and is available for use." *Lemelson v. United States*, 752 F.2d 1538, 1548 (Fed. Cir. 1985). Similarly, in *Deepsouth Packing Co., Inc. v. Laitram Corp.*, 406 U.S. 518, 528 (1972), *cert. denied*, 409 U.S. 902 (1972), this Court held "a patent on a combination is a patent on the assembled or functioning whole, not on the separate parts" (quoting from *Mercoid Corp. v. Minneapolis-Honeywell Regulator Co.*, 320 U.S. 680 (1944), *cert. denied*, 321 U.S. 802 (1944). Accordingly, only systems including *integrated circuits that are assembled and programmed* to perform in the manner claimed can infringe the '351 and '660 patents. The evidence below showed that nobody has ever assembled and programmed AMD products in this manner.

Constant cites *Paper Converting Machine Co. v. Magna-Graphics Corp.*, 745 F.2d 11 (Fed. Cir. 1984) for the proposition that the manufacture and sale of integrated circuits capable of a multitude of uses constitutes infringement if they *could* possibly be assembled and programmed in an infringing manner. In fact, *Paper Converting* is inapposite. In *Paper Converting*, the allegedly infringing apparatus had only one realistic and intended use, which infringed a patent.

In the present case, the District Court found (Pet. App. at B-4) and Petitioner concedes (Petition p. 15) that devices in AMD's 29300 and 29500 families of integrated circuits have a multitude of uses and could be programmed to perform an infinite number of operations. Thus Constant's reliance upon *Paper Converting* is misplaced.

Constant also argues that "systems" suggested in AMD's literature "are specially designed for programs implementing infringing algorithms (FFT, IIR, FIR, division, multiplication)." (Petition at 13.)[1] The '351 and '660 patents do not claim all FFT, IIR, FIR, division and multiplication algorithms. If the claims cover all such algorithms, they are plainly invalid. Division and multiplication, for example, clearly predate Constant's patents. More importantly, even if AMD did teach customers how to infringe Constant's patents (which it did not), if nobody infringed the patents, there is no infringement. *Hautau v. Kearney & Trecker Corp.*, 179 F.Supp. 490, 492 (E.D. Mich. 1959). Petitioner's reference to documents discussing purported infringing uses (Petition pp. 5-7) cannot support a contrary finding. The decisions below recognized this and were correct.

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[1] FFT, IIR and FIR are acronyms for "fast Fourier transform", "infinite impulse response" and "finite impulse response", respectively. "Fast Fourier transforms" are used to provide a spectral analysis of a signal. "Infinite impulse response" pertains to filters which respond to an impulse input signal by providing an output signal that does not decay to zero. "Finite impulse response" refers to filters which respond to an impulse input signal by providing an output signal which eventually decays to zero.

C. The District Court Properly Determined that No Contributory Infringement or Inducement of Infringement Occurred.

In *Deepsouth, supra*, this Court stated "In a word, if there is no [direct] infringement of a patent, there can be no contributory infringer." 406 U.S. at 526, quoting *Mercoid Corp. v. Mid-Continent Invest. Co.*, 320 U.S. 661 (1944), *cert. denied*, 321 U.S. 802 (1944). Accordingly, since no evidence could support a finding of direct infringement of the '351 and '660 patents there can be no finding of contributory infringement.

It is also clear that "(p)roof of inducement of infringement under 35 U.S.C. 271(b) requires proof of direct infringement of all of the elements of the claim." *Nationwide Chemical Corp. v. Wright*, 458 F.Supp. 828, 839 (M.D. Fla. 1976), *aff'd* 584 F.2d 714 (5th Cir. 1978). The decisions below were correct and no evidence which would support a contrary conclusion exists.

II.

The District Court properly considered the validity of the '660 Patent.

The District Court's order of January 27, 1989 (Pet. App. at B-2) found the '660 Patent not infringed by the 29300 and 29500 families of AMD products. Constant also contended that other products (AMD's 7910/11 and 79C12/C14 products) infringed the '660 Patent and pursued a motion for summary judgment upon that claim after the District Court's January 27, 1989 decision. (See, Petition p. 49.) After the January 27, 1989 order, the District Court found that the '660 Patent was invalid. (Order dated March 16, 1989, Pet. App. at B-10.) The District Court thus determined that the '660 Patent was invalid while Constant's infringement claims relating to other AMD devices were pending. The question of the validity of the '660 patent was not moot because the parties continued to have a "legally cognizable interest in the outcome." *Murphy v. Hunt*, 445 U.S. 478, 481 (1982). *Advance Transformer Co. v. Levinson*, 837 F.2d 1081 (Fed. Cir. 1988), cited by Constant, involved an entirely different procedural situation and is inapposite.

III.

The District Court properly determined that the '660 Patent is invalid for obviousness.

The District Court held Constant's '660 Patent to be obvious in light of the Bird patent (U.S. Patent No. 3,553,651) and the Springer article. (Pet. App. at B-17 and B-18.) Contrary to Petitioner's assertion, Constant's '635 Patent was not relied upon as prior art in the District Court's determination of obviousness. *Id.* The determination of the District Court was correct and no evidence exists which could support a contrary conclusion.

A. Constant's Collateral Estoppel Argument Misconstrues the District Court's Decision.

Constant argues that the District Court erred in applying the doctrine of collateral estoppel. Constant misconstrues the District Court's decision. The District Court merely recognized that certain facts relating to the '635 patent were determined in *Constant v. Advanced Micro-Devices,* 848 F.2d 1560 (Fed. Cir. 1988) (hereinafter cited as *Constant v. AMD*) and recognized that Constant is collaterally estopped from disputing those facts. The District Court did *not* hold that the '635 patent was prior art. The District Court did *not* hold that the mere fact that the '635 patent was obvious meant that the '660 patent was obvious. Rather, the Court looked to *Constant v. AMD* for its factual determination of what Springer disclosed and the differences between Springer and Claim 1 of the '635 patent. In its analysis of obviousness, the District Court correctly applied the test set forth in *DMI, Inc. v. Deere & Co.*, 802 F.2d 421, 425 (Fed. Cir. 1986). (Pet. App. at B-13 *et seq.*) *DMI, Inc.* sets forth the factual inquiry

described by this Court in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The District Court properly applied the doctrine of collateral estoppel.

B. The District Court Properly Considered Springer and Bird Together as Prior Art Against the '660 Patent.

The Bird LIFO circuit is a "system for the digital time scale inversion of signals" as set forth in Claim 1 of the '660 patent. Springer's relevance is made clear, *inter alia*, by *Constant v. AMD*. No authority supports Constant's contention that the District Court erred because it did not explicitly state a reason for combining the references.

Constant argues that if Bird and Springer do not perform the *exact* function in his '660 patent, Bird and Springer cannot be considered prior art. (Petition p. 34.) Constant asserts that this rule is mandated by 35 U.S.C. 112.

There are at least three flaws with this argument:

1. Constant is wrong on the law. Section 112, paragraph 6 does not define what is prior art. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987), *cert. denied*, 108 S.Ct. 1226 (1988); *cert. denied*, 108 S.Ct. 1474 (1988), cited by Constant, simply has nothing to do with this question.

2. It is completely contrary to *Constant v. AMD*, which held that Springer was prior art against an almost identical patent claim.

3. The record below shows that Bird *does* perform time inversion as claimed by Constant. Data arrives in a first order and is provided in the time reverse order. (Appellee's Fed. Cir. App. p. 297.)

Constant next argues (Petition p. 35) that Springer and Bird are not prior art because the District Court should have considered other references to be more pertinent. Constant alleges that these other references specifically teach filters and Springer and Bird do not.

There is no genuine issue of material fact on this issue because:

1) The '660 patent is not limited to filters.

2) The Federal Circuit has already considered and rejected this argument. Specifically the Federal Circuit held that Springer was prior art against the '635 patent. *Constant v. AMD*, 848 F.2d at 1570. If Springer and Bird are prior art against the '635 filter patent, then Springer and Bird *must* be prior art against the '660 patent which is broader than the '635 filter patent.

Constant next argues (Petition at pp. 37-38) that the Springer and Bird memories operate at the same input and output rate (clock rate). Constant contends that this feature makes the Springer and Bird memories unsuitable for use in the '635 and '660 filters, all of which require low input rates and high output rates to obtain pulse compression. There is no genuine issue of material fact on this issue because:

1) The '660 patent is not limited to any type of filter.

2) Constant's argument is contrary to the Federal Circuit's holding that Springer rendered obvious the '635 patent.

The Springer and Bird articles are prior art, and were correctly considered by the District Court.

Constant's contention that the District Court employed numerous references "as a mosaic to recreate a facsimile of the claimed invention," (Petition p. 40) is refuted by the record. The District Court combined *two* references. One (Springer) disclosed every element but

one of the claimed device. The other (Bird) provided the missing element. (Pet. App. at B-17 to B-19.) This is hardly the mosaic of antithetical references discussed in *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1051-1052 (Fed. Cir. 1988), *cert. denied*, 109 S.Ct. 75 (1988), cited by Constant.

C. The District Court Properly Determined the Level of Ordinary Skill in the Art.

Constant contends that the District Court erred in its finding of fact concerning the level of ordinary skill in the art. AMD submitted evidence to the District Court in the form of a Declaration by Philip Freidin concerning the level of skill in the art. (Appellee's Fed. Cir. App. page 267.) Constant never submitted contrary evidence. The District Court properly acted on the only evidence it had before it. There is no evidence in the record to support the conclusions in Constant's brief. Accordingly, there is no evidence to support a contrary finding and the District Court's order was proper. *Anderson v. Liberty Lobby, Inc., supra.*

D. The District Court Properly Evaluated Obviousness in Light of Springer and Bird.

The Federal Circuit has previously held that the *only* difference between Springer and Constant's '635 patent is that Springer is not a recursive filter implemented as a matched clutter filter. *Constant v. AMD*, 848 F.2d at 1570. Claim 1 of the '660 patent is *not* limited to a recursive filter implemented as a matched clutter filter. The only limitation present in '660 Claim 1 that is not present in '635 Claim 1 is time inversion. Bird contains *all* of the relevant subject matter disclosed in the Springer *plus* time inversion. (See, Table I, Appellee's Fed. Cir. Brief.) Thus, the '660 patent must be obvious in light of Bird.

More importantly, the record (Pet. App. at B-10 to B-20) reflects a careful and correct analysis of validity using the method of analysis set forth in *Graham v. John Deere Co., supra.* No reason is given for this Court's reconsideration of that analysis.

E. The Record Contains No Evidence of Commercial Success Sufficient to Support a Finding of Nonobviousness.

Constant asserts that the District Court erred by not considering "secondary considerations", and that if AMD's 7910/11 and 79C12/C14 were found to infringe the '660 patent, evidence of "secondary considerations" would support validity. (Petition p. 48.) Constant cites *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538 (Fed. Cir. 1983), *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. den.*, 469 U.S. 851 (1984) and a number of other cases in support of this proposition. Constant also argues that the issue of infringement of the '660 patent must be decided before the issue of obviousness of that patent is reached. (Petition p. 48.) Constant's theory appears to be that if he were permitted to demonstrate that AMD's 7910/11 and 79C12/C14 products infringe the '660 patent, such infringement could constitute evidence of secondary considerations. Constant is incorrect because:

1) Constant never proffered any evidence of commercial success.

2) Constant could have proffered evidence that the 7910/11 and 79C12/C14 devices infringe his '660 patent prior to the determination of invalidity. He did not.

3) Constant never proffered any evidence that the 7910/11 or 79C12/C14 devices were commercially successful.

4) Even if there were some evidence in the record that these devices were successful (which there isn't), Constant never proffered evidence that there

> was a nexus between his invention and such commercial success as required by *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985).

Therefore, the District Court correctly determined that the "objective evidence does not support a finding of nonobviousness." (Pet. App. at B-19.)

Constant argues that "The court's judgment that the '660 patent is invalid before a full adjudication of the infringement of that patent by AMD was made is error and deprives Petitioner's due process." (Petition p. 50.) In response to a similar argument by Constant, the Federal Circuit in *Constant v. AMD* stated:

> [I]t is unambiguously clear that federal judicial proceedings, with their extensive notice, opportunity to be heard, and procedural protections, satisfy the constitutional requirement of procedural due process required for the invalidation of a patent. [848 F.2d at 1565.]

Constant received all such notice, opportunity to be heard and procedural protections. *See, also, Avia Group International, Inc., supra.*

There is no rule requiring trial courts to determine validity *and* infringement, instead of validity alone on summary judgment. However, there is a preference for determining both validity and infringement if a case goes to trial. *See, Medtronic, Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1582 (Fed. Cir. 1983). Contrary to Constant's assertion (Petition p. 3) there was no "bench trial" in this matter, so even that preference is inapplicable. The rule asserted by Constant requiring an infringement trial upon a patent previously found invalid defies reason. It is assuredly within the District Court's inherent power to regulate litigation before it to refuse to conduct such a trial. It cannot be reasonably asserted that the District Court abused its discretion in refusing to do so.

IV.

The District Court properly found that AMD does not infringe the '458 Patent.

A. The Prosecution History Forecloses the Claim Construction Now Advanced by Constant.

Constant attacks the District Court's ruling that the '458 claims must be construed in light of arguments made by Constant before the U.S. Patent and Trademark Office.

In its order, the District Court held that Constant's claims must be interpreted in light of the file history. (Pet. App. at B-21 to B-29.) Constant argues that AMD cannot use the doctrine of "file wrapper estoppel" in construing the '458 claims.

Constant argues "once literal infringement is found, the doctrine of file wrapper estoppel is inapplicable." (Petition p. 55.) Constant apparently fails to recognize that to determine the issue of literal infringement, claims construction is necessary. Constant cites *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861 (Fed. Cir. 1985). *Loctite v. Ultraseal* states that to ascertain the true meaning of disputed claim language, resort should be made to the claims at issue, the specification, and the prosecution history. 781 F.2d at 867. The court in *Loctite* performed claims construction in its determination of literal infringement. Thus, in the determination of literal infringement the meaning given to terms in a claim depends on the meaning that was attached to the claims during the prosecution. *Accord, Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985).

Even if Mr. Constant is correct that "file wrapper estoppel" is not the name of the applicable doctrine, the principles involved in the District Court's opinion below are completely correct, *i.e.*, the prosecution history limits the interpretation of claims so as to exclude any interpretation that may have been specifically disclaimed or disavowed during prosecution in order to obtain claim allowance. *Standard Oil Co. v. American Cyanamid Co., supra*, 774 F.2d at 452.

Constant specifically disclaimed the interpretation of the '458 claims that he now urges. Claim 17 of the '458 patent includes the following elements:

> a first memory means for storing a first signal S, said first memory means having storage locations for n words Sn;
>
> a second memory means for storing a second signal K, said second memory means having storage locations for n words Kn. . . .

Constant distinguished the '458 claims over the prior art by arguing that the above claim language meant that the first and second memory means *each* required a *plurality* of locations. See the Amendment dated January 24, 1978. (Appellee's Fed. Cir. App. pages 321-324.) During depositions, Constant admitted as much. (Appellee's Fed. Cir. App. pages 327-328.)

Constant now asserts that his first and second memory means do *not* require a plurality of locations. Such claim interpretation is foreclosed by the file history. Constant's contention that "literal infringement is present" is also incorrect. Construed in light of the prosecution history, the claims are not infringed.

V.

Petitioner has failed to provide any reason why a writ of certiorari should be granted.

This Court has stated, " '[I]t is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal.' " *Rice v. Sioux City Memorial Park Cemetery,* 349 U.S. 70, 79 (1955) (quoting *Layne & Bowler Corp. v. Western Well Works, Inc.,* 261 U.S. 387, 393 (1923).

Petitioner's claims affect only the parties involved, and are meritless. As such, this Court should " 'adhere to the usual rule of noninterference where conclusions of Circuit Courts of Appeal depend on appreciation of circumstances which admit of different interpretations.' " *National Labor Relations Board v. Pittsburgh S.S. Co.,* 340 U.S. 498, 503 (1951), (quoting *Fed. Trade Comm'n v. American Tobacco Co.,* 274 U.S. 543, 544 (1927). *Accord,* Sup. Ct. Rule 17(c). Although the Petition gives lip service to the considerations governing review on certiorari set forth in Rule 17, the Petitioner fails entirely to demonstrate a conflict between the rulings below and those of any other Court and has similarly failed to demonstrate *any* departure from the "usual proceedings."

VI.

Conclusion

Petitioner would have this Court reconsider the merits of a complex patent matter, correctly decided below, of no interest to anyone other than the parties. This Court should decline to use its limited resources to do so.

For the above reasons, the Petition should be denied.

Dated: December 26, 1989

Respectfully submitted,

ANTHONY de ALCUAZ
SKJERVEN, MORRILL, MacPHERSON,
FRANKLIN & FRIEL
25 Metro Drive, Suite 700
San Jose, California 95110
Phone: (408) 283-1222

Attorneys for Plaintiff
Advanced Micro-Devices, Inc.